



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,082	02/25/2004	Jessica E. Barzilai	07414.0009-01	8544
22852	7590	11/25/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SIEFKE, SAMUEL P	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			11/25/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,082

Applicant(s)

BARZILAI ET AL.

Examiner

SAM P. SIEFKE

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-51, 53-56 and 58-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 49-51, 53-56 and 58-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date ____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Information Disclosure Statement

The two Japanese documents are not considered in the IDS as the Office does not consider an interpretation of a reference from a foreign office. The Applicant must submit a translated English abstract for the two documents to be considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 49-51, 53-56 and 58-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (USPN 4,981,801).

Suzuki discloses a system comprising a thermal cycling device (fig. 7, ref. 71-75) having a sample block with a plurality of openings for receiving a sample well tray (88); a sample well tray handling apparatus (fig. 7-10) configured to take a sample well tray from a first location, place the sample well tray into the thermal cycling device at a second location and then later remove the sample well tray from the thermal cycling device and return the sample well tray to the first location (col. 11, lines 18-col. 12, lines 67); the sample well tray handling apparatus comprising a sample well tray holder (90), a

rotational actuator (fig. 8, ref. 93 and fig. 9) configured to rotate the sample well tray holder, and an extension arm (90) extending from the rotational actuator and being connected (89) to the sample well tray holder. Regarding claim 47, the Examiner states that when the sample well tray is taken from the thermal cycling device the sample well tray holder (90) urges the sample well tray in a direction away from the sample block of the thermal cycling device because it picks up and moves to another station. Regarding claim 48, a robot with a robotic arm configured to transport the sample well tray to the first location is disclosed in fig. 2).

Response to Arguments

Applicant's arguments filed 9/8/09 have been fully considered but they are not persuasive. Applicant argues, "In response, Applicants respectfully submit that the relied on disclosure of Suzuki fails to disclose a system for manipulating and thermal cycling a sample well tray, comprising only one sample block for receiving the sample well tray. In contrast, the relied on disclosure of Suzuki involves a system having a plurality of sample blocks." Examiner states that "comprises" language is open ended claim language which allows for more than one sample block to exist in the prior art. The Examiner designates only one of the sample blocks of the prior art as the only one sample block of the instant application for receiving a sample well tray. If Applicant requires "only one" sample block then the claim language needs to include "consisting" instead of "comprising." What prevents the claim as is stands right now from reading on prior art that has a plurality of sample blocks, where in only one is capable of

receiving a sample well tray while the other sample blocks are for receiving individual samples instead of a big tray? There still is a plurality of sample blocks but only one is structurally capable of receiving a sample well tray. This is why the Office can designate only one of the sample blocks of Suzuki to receive the sample well tray.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **SAM P. SIEFKE** whose telephone number is (571)272-1262. The examiner can normally be reached on **M-F 7:00am-5:00pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel P Siefke/
Primary Examiner, Art Unit 1797